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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,693	10/17/2003	Edward Flory	27475/06642	2692
24024	7590	06/19/2006	EXAMINER	
CALFEE HALTER & GRISWOLD, LLP 800 SUPERIOR AVENUE SUITE 1400 CLEVELAND, OH 44114			BARRETT, SUZANNE LALE DINO	
			ART UNIT	PAPER NUMBER
			3676	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/605,693	Applicant(s) FLORY ET AL.	
	Examiner Suzanne Dino Barrett	Art Unit 3676	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Upon further consideration of the claims and prior art of record, it was determined that a rejection under 35 USC 112 is warranted as set forth below and that the prior art is applicable to claims 19-23. The examiner regrets any inconvenience.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 19-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the combination changing method, does not reasonably provide enablement for the lock remaining locked during the combination changing method. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The “wherein” clause of claim 19 does not have sufficient support in the specification. It appears to suggest that the key lock cylinder remains locked, however, if the key is rotated (implicitly to an unlocked position) in step 2 of the claim, how can the cylinder remain in the locked position?

The recitation that “the lock remains locked while the combination is changed” is inconsistent with the language in claim 19 which recites that the key is rotated, the

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combination is changed then in the next step, the key is turned back to the locked position. It is not understood how the lock can remain in the locked position while changing the combination, if it's claimed as being *turned back* to the locked position *after* changing the combination.

4. Claims 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It does not appear that the "wherein" clause of claim 19 has sufficient structural support in the claim. How can the key be rotated (to the unlock position) while the "lock remains locked"? Furthermore, there is no antecedent basis for "the locked position" in line 6 of claim 19.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 19,20,23, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by either Walby 6,708,538 or Berkowitz 3,395,557. Walby teaches a combination lock having a dial 18 with a key cylinder 20/16 and dial cam arrangement

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32A mounted therein and wherein the key and cam 32A (tumbler dial) provide the combination changing means. The combination is changed (col.8, lines 1-14) by rotating the key to decouple the dial pin 38 on number dial 18 from the cam (tumbler dial) drive holes 40 to allow rotation of the number dial 18 to a new position indicated by a marker on the front face of the dial 18. The claimed method steps are considered inherent to the use of the combination changing means as set forth in Figures 22-26 and col.7, line 36 - col.8, lines 1-14, which clearly recites rotating the key counterclockwise to effect decoupling of the number dials to change the combination code. Note that col. 6, lines 64-65 recites that the unlocking function is effected by turning the key in a clockwise direction, therefore, the lock is not unlocked to change the combination code.

Furthermore, Berkowitz also teaches combination lock having a dial 60 with a key cylinder plug 100 and engaging means 124/126 provide the combination changing means by decoupling 124/126. The combination is changed (Fig. 14; col.7, lines 43-72) by rotating the key counterclockwise to decouple the elements 124/126 to allow rotation of the number dial 60 to a new position indicated by a marker on the front face of the dial 60. The claimed method steps are considered inherent to the use of the combination changing means as set forth in Figure14 and col.7, lines 43-72) which clearly recites rotating the key counterclockwise to effect decoupling of the number dials to change the combination code. Note that col. 6, lines 74-75 and col. 7, line 2-3, recite that the unlocking function is effected by turning the key in a clockwise direction, therefore, the lock is not unlocked to change the combination code.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walby '538 or Berkowitz '557 in view of Hermann 3,383,886. Walby fails to teach an offset key cylinder lock. Hermann teaches a combination dial and key cylinder lock wherein the key cylinder 6/8 is offset from the combination dial center portion 1,2. It would have been obvious to modify the shape of the combination dial to provide an offset key cylinder hole as taught by Hermann as an obvious matter of design choice.

9. Claim 22 is, as best understood, rejected under 35 U.S.C. 103(a) as being unpatentable over Walby 6,708,538 or Berkowitz 3,395,557. Walby and Berkowitz fail to specifically teach the number of available combination code changes, however, it would have been well known to one of ordinary skill in the lock art to provide the combination lock with enough code disks needed to provide the desired number of code changes, such as the claimed ten changes, as an obvious matter of design choice.

Response to Arguments

10. Applicant's arguments with respect to claims 19-23 have been considered but are moot in view of the new ground(s) of rejection. As set forth above, upon further review of the prior art and an update search, it was determined that several issues under 35 USC 112 remain, and that furthermore, Applicant's previously persuasive arguments were, in fact, erroneous.

With respect to the rejections under 35 USC 112, as discussed above, it is not understood how the key is rotated (implicitly to the unlocked position), then rotated "back to the locked position", while the "lock remains locked". Perhaps it is the latch which remains in the keeper in a latched position? If that is the case, the preamble should be amended to include a --A method of changing the combination of a locker lock having a latch--. Furthermore, upon additional review of the previously cited Walby and Berkowitz disclosures, it was apparent that both these patents teach the method steps as claimed, wherein the key is rotated counterclockwise to effect decoupling and allow the combination to be changed, then rotated back to the locked position; while the unlock position is effected by rotating the key clockwise. Accordingly, this is a new non-final action.

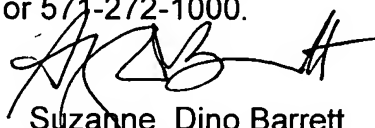
Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb